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AUG 3 2004

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In re Application of :
HYLDIG-NEILSON et al :
Serial No.: 09/593,914 : Decision on Renewed Petition
Filing Date: 14 June 2000 :
Attorney Docket No. BP9901-US :

This decision is in response to a renewed Petition under 37 CFR 1.144 filed on 27 April 2004 and also addresses the Petition under 37 CFR 1.181 filed on 20 May 2004 and a first Petition under 37 CFR 1.144 filed 25 August 2003. The petitions filed in 2004 were only recently brought to the attention of the deciding official. The delay in acting upon this petition is regretted.

BACKGROUND

A review of the file history shows that on 18 July 2001, among the pending claims 1-34, 46-49, 60-62, 72 and 80-85, the Examiner selected a certain subset of claims (10, 11, 21, 22, 34, 61 and 62) and made a eleven-way Restriction Requirement solely among this subset of claims directed towards SEQ ID Nos 1-11, respectively. All of "Groups" I-XI were classified in Class 435, subclass 6 and Class 536, subclass 24.32.

The Examiner reasoned that the inventions are distinct, each from the other because of the following reasons:

> Inventions I-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP 806.04, MPEP 808.01). In the instant case the different inventions are drawn to distinct probes each comprising a unique nucleotide sequence and thereby each having unique functional properties. These sequences are thus deemed to constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to

represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1 .14, (sic, 1.144).

The Examiner supported this restriction because she reasoned that the search was divergent and the inventions were distinct.

Relevant claims are reproduced below:

1 . An enzyme-linked in-situ hybridization probe further characterized in that it comprises a probing nucleobase sequence that specifically hybridizes to a yeast specific target sequence.

10. An enzyme-linked probe for detecting, identifying or quantitating the presence of Dekkera/Brettanomyces yeast in a sample of interest, wherein the probe comprises a probing nucleobase sequence wherein at least a portion of the probing nucleobase sequence is at least ninety percent homologous to the nucleobase sequences selected from the group consisting of: AGC-GGG-TCT-ATT-AGA (Seq. ID No. 1), CCA-GGT-GAG-GGT-CGC (Seq. ID No. 2); CGG-TTG-CCC-GAT-TTC (Seq. ID No. 3), TCG-CCT-TCC-TCC-TCT (Seq. ID No. 4); CGG-TCT-CCA-GCG-ATT (Seq. ID No. 5); CAC-AAG-ATG-TCC-GCG (Seq. ID No. 6); GCG-GGC-ACT-AAT-TGA (Seq. ID No. 7); CAT-CCA-CGA-GGA-ACG (Seq. ID No. 8); GTG-TAA-ACC-AGG-TGC (Seq. ID No. 9); ATG-GCT-CCC-AGA-ACC (Seq. ID No. 10) and GAC-AGA-ATC-GAA-GGG (Seq. ID No. 11) and sequences fully complementary thereto and of the same length.

11. The probe of claim 10, wherein the probing nucleobase sequence is selected to be one hundred percent homologous to a nucleobase sequence identified in the claim.

21. A set of enzyme-linked probes for detecting, identifying or quantitating Dekkera/Brettanomyces yeast in a sample of interest, wherein one or more of the probes comprise a probing nucleobase sequence wherein at least a portion of the probing nucleobase sequence is at least ninety percent homologous to the nucleobase sequences selected from the group consisting of: AGC-GGG-TCT-ATT-AGA (Seq. ID No. 1), CCA-GGT-GAG-GGT-CGC (Seq. ID No. 2)., CGG-TTG-CCC-GAT-TTC (Seq. ID No. 3), TCG-CCT-TCC-TCC-TCT (Seq. ID No. 4), CGG-TCT-CCA-GCG-ATT (Seq. ID No. 5), CAC-AAG-ATG-TCC-GCG (Seq. ID No. 6), GCG-GGC-ACT-AAT-TGA (Seq. ID No. 7); CAT-CCA-CGA-GGA-ACG (Seq. ID No. 8)., GTG-TAA-ACC-AGG-TGC (Seq. ID No. 9); ATG-GCT-CCC-AGA-ACC (Seq. ID No. 10) and GAC-AGA-ATC-GAA-GGG (Seq. ID No. 11) and sequences fully complementary thereto and of the same length.

22. The probe set of claim 21, wherein the probing nucleobase sequences of said one or more probes are selected to be one hundred percent

homologous to a nucleobase sequence identified in the claim.

Applicants elected Group I with traverse.

In the next Office action, the examiner considered the traversal with regard to the search burden and made the restriction requirement final as follows:

> This is not found persuasive because a search of invention I (SEQ ID NO: 1) would not lead one of skill in the art to references teaching inventions II-XI (SEQ ID NO: 2- 11). A search of the distinct inventions would not be co-extensive as evidenced by the requirement for searching different keywords and nucleic acid sequences. Therefore, it is maintained that undue burden would be required to examine each of the claimed inventions. Accordingly, the requirement is still deemed proper and is therefore made FINAL.

A first Petition was filed 25 August 2003 under 37 CFR 1.144. A draft petition decision lacking the deciding official's signature, was inadvertently and prematurely sent to applicants on March 3, 2004. This first petition decision has been vacated. Any confusion caused by the mailing of this erroneous decision is regretted.

Subsequent to the filing of the first petition, a Final Office action was mailed by the Office. Applicants filed their Appeal Brief on 27 April 2004. The Office mailed a letter concerning the Appeal Brief of 30 April 2004.

DISCUSSION

The application, file history and petitions have been considered carefully.

The petitioner requests reconsideration of the restriction imposed on claims 10, 11, 21, 22, 34, 61 and 62. The petition points to *In re Weber*, 580 F.2d, 455, 198 USPQ (CCPA, 1978) and *In re Haas*, 198 USPQ 334. Applicants are correct in their position that the Office may not use restriction as a means to require applicants to limit all claims to the elected invention, SEQ ID No 1.

The petition states that because the groups are all classified in the same class and subclass, the examiner has not established burden of search. Concerning the burden of search, the Examiner has not provided sufficient reasons as to why a concurrent search of more than one sequence would be burdensome.

Moreover, a review of the restriction requirement identifies the following errors:

(1) The Groups do not take into account all of the claims. Claims 1-9, etc, are missing from the groups. Claims 23, 25, etc, which depend upon restricted claims are also missing from the Groups. The action does not indicate how the missing claims would be treated.

(2) The Groups are set forth in such as way as to require applicant to pick one sequence for examination, even though certain claims are directed to sets of sequences (see claim 21) or methods of using a plurality or sets of sequences (see claim 46, 61). The restriction requirement intends to limit the scope of the claims under examination. Applicants have a right to have their sets of sequences examined together.

(3) Claim 1, for example, appears to encompass the scope of all of Groups I-XI. All eleven sequences are enzyme linked in situ hybridization probes which comprise a probing nucleobase sequence that specifically hybridizes to a yeast specific target sequence. Thus all of the groups fall within the scope of apparently unrestricted claim 1. As such, claim 1 is not independent and distinct from Groups I-XI. For this reason, there is overlap between the inventions as grouped. If the Groups I-XI had been properly restricted, Applicants should have been informed of how claim 1, etc, would have been treated under linking claim practice, using Form Paragraph 8.12. This was not done.

(4) Turning now to the reasons, the explanation that the sequences are unrelated is erroneous and unfounded. A review of the claim set shows that the sequences are indeed capable of being used together in a similar mode of operation for a similar function (see method claim 61).

For these reasons, the restriction requirement is improper.

MPEP 802.01 which states that in order for a restriction to be proper, the claimed inventions must be independent and distinct. MPEP 802.01 defines "independent" and "distinct" as follows:

> INDEPENDENT
>
> The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.
>
> DISTINCT
>
> The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects. It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended.

The restriction requirement could only have been proper if the overlap in scope between "Groups" I-XI and Claim 1, for example, had been properly addressed by the guidance of MPEP 809, concerning treatment of linking claims. The restriction requirement among the linked inventions would then have been subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Even if the restriction requirement between Groups I-XI had been proper, the Examiner failed to identify, address or properly treat the linking claims.

For these reasons, the restriction requirement between Group I-XI is in error and is withdrawn.

DECISION

The petition under 37 CFR 1.144 filed on 27 April 2004 is **GRANTED** for the reasons set forth above.

The finality of the Office action mailed 25 February 2003 has been vacated in view of the restriction requirement being withdrawn. An action on the merits, consistent with this decision, will follow.

Because prosecution will be reopened, the petition under 37 CFR 1.181 filed on 20 May 2004 concerning the notice of non-compliance of the Appeal Brief is considered moot and is **DISMISSED**.

Applicants may request a refund of their Notice of Appeal and Appeal Brief fees.

Should there be any questions with regard to this letter, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, PO Box 1450, Alexandria VA 22313-1450 or by telephone at (571) 272-1600.

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